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In re Application of
TAKANO et al.
Application No.: 10/562,043
PCT No.: PCT/JP04/09057
Int. Filing Date: 21 June 2004
Priority Date: 23 June 2003
Attorney Docket No.: 24082-9
For: HEALTH CARE SYSTEM, BIOLOGICAL
INFORMATION TERMINAL

DECISION ON REQUEST
UNDER 37 CFR 1.497(d)

This is a decision on applicants' "Response to Notification of Missing Requirements under 35 U.S.C. 371", treated as a petition to correct inventorship under 37 CFR 1.497(d), filed on 18 September 2006 in the United States Patent and Trademark Office (USPTO). Petitioner seeks to add JAMES MILLER and STEVEN SUTPHEN as inventors in the above referenced application. The requisite \$130 petition fee was paid,

BACKGROUND

On 23 December 2005, applicant filed a Transmittal Letter requesting entry into the national stage in the United States of America under 35 U.S.C. § 371 with, *inter alia*, the requisite basic national fee.

On 10 July 2005, a Notification of Missing Requirements was mailed to applicant indicating that an oath or declaration, in compliance with 37 CFR 1.497(a) & (b), and the surcharge for filing the oath or declaration after the thirty month period, was required.

On 18 September 2006, applicant filed a response to the Notification of Missing Requirements along with a petition for correction of inventorship to add JAMES MILLER and STEVEN SUTPHEN as inventors. In addition to the \$130 petition fee, Petitioner provided the statement of the inventors Miller and Sutphen in support of the correction of inventorship under 37 CFR 1.497(d). An executed declaration was provided.

DISCUSSION

37 CFR 1.497(d) states, in part: If the oath or declaration filed pursuant to 35 U.S.C. 371(c)(4) and this section names an inventive entity different from the inventive entity set forth in the international application, the oath or declaration must be accompanied by:

- (1) A statement from each person being added as an inventor . . . that any error in inventorship in the international application occurred without deceptive intention on his or her part;
- (2) The processing fee set forth in § 1.17(i); and

(3) If an assignment has been executed by any of the original named inventors, the written consent of the assignees.

Applicant provided statements signed by JAMES MILLER AND STEVEN SUTPHEN stating that the error in inventorship "occurred without deceptive intention on my part." This statement satisfies item (1) of 37 CFR 1.497(d).

The processing fee of \$130.00 has been paid, satisfying Item (2) above.

With regard to Item (3), the written consent of the assignees, University of Alberta and Seiko Instruments, consenting to the addition of JAMES MILLER AND STEVEN SUTPHEN as inventors in this application was submitted. Item (3) above is satisfied.

Accordingly, applicant has met all of the requirements of 37 CFR 1.497(d) to add JAMES MILLER AND STEVEN SUTPHEN as co-inventors in the above-identified international application.

However, with regard to the declaration submitted, it appears to be a composite declaration created from the combination of separately executed declarations. The declaration is not properly executed because the declaration contains three Page 3s. It appears that either the attorney pieced together separate complete declarations into one composite declaration or that the inventors were presented with an incomplete declaration. While it is acceptable for applicants to execute separate copies of the declaration, the entire declaration, as executed by the inventor, must be submitted. "Where individual declarations are executed, they must be submitted as individual declaration rather than combined into one declaration." See MPEP 201.03. What is required is one declaration where all inventors have signed or separate complete declarations. The requirements of 37 CFR 1.497 (a) and (b) have not been met and the declaration is unacceptable as filed.

CONCLUSION

For the reasons discussed above, the submission under 37 CFR 1.497(d) to add JAMES MILLER AND STEVEN SUTPHEN as inventors are hereby **GRANTED**.

The declaration as submitted is not in compliance with 37 CFR 1.497(a) and (b). Applicant must submit a newly executed declaration, in compliance with 37 CFR 1.497(a) and (b).

Applicant's response must be filed within TWO (2) MONTHS from the mail date of this decision. No petition fee is required. Any further extensions of time available may be obtained under 37 CFR 1.136(a).

Any further correspondence with respect to this matter should be addressed to the Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.


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